

REMARKS

Applicants appreciate the consideration of the present application afforded by the Examiner. Claims 1 and 11 are currently pending. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

Interview Summary

Applicants appreciate the telephone interview afforded by the Examiner on August 21, 2007. During the interview, Applicants presented the arguments submitted herewith.

Although no definitive agreement was reached, the Examiner indicated that he would give consideration to the arguments against the prior art when presented in a formal response. Some of the arguments presented by the Examiner are addressed by the remarks regarding the § 102(e) rejection, presented below.

Claim Rejections - 35 U.S.C. §102

Claim 1 and 11 stand rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 5,696,576 to Itoh et al. ("Itoh"). Applicants submit the Examiner has failed to establish a *prima facie* case of anticipation and traverse the rejection.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. §102, the cited reference must teach or suggest each and every element in the claims. *See M.P.E.P. §2131; M.P.E.P. §706.02*. Accordingly, if the cited reference fails to teach or suggest one or more claimed elements, the rejection is improper and must be withdrawn.

Independent claim 1 recites, *inter alia*,

An image processing apparatus capable of accessing a recording medium on which both image data representing a plurality of images and image recording time data representing times at which the image data is recorded are electrically recordable and erasable, comprising:

an ordered-image designating device for designating an ordered image to be printed from among images represented by image data that has been stored on the recording medium; and

an ordering information record control device for electrically recording on the recording medium, in association with the image data representing the ordered image, ordering information for the ordered image designated by said ordered-image designating device and designation time data representing time at which the ordered image is designated. (Emphasis added.)

Owing to the features of the present invention, image data representing a plurality of images and image recording time data representing times at which the image data is recorded are both electrically recordable and erasable on a recording medium readable by an image processing apparatus. Furthermore, said image processing apparatus comprises an ordering information record control device which records, on the recording medium, ordering information and designation time data representing the time at which the ordered image is designated. Itoh fails to expressly disclose or suggest at least these features of the present invention.

The Itoh reference is directed to a magnetic track 114 provided on a photographic film 110 on which images have been exposed by conventional film image photography. *See Abstract, Figure 3*. Although the magnetic track may be recordable and erasable, the photographic film containing the image data is not electrically recordable and erasable. Therefore, the Itoh reference fails to teach or suggest at least the feature of the instant invention whereby image data representing a plurality of images is electrically recordable and erasable because the image data of Itoh is contained wholly on the non-erasable photographic film. For at least this reason, claim 1 is distinct from Itoh.

During the interview, the Examiner indicated that he interprets “image data representing a plurality of images” as reading on the information being stored on the magnetic track disclosed by Itoh. More specifically, the Examiner contends that data on the magnetic track, such as a title, photographing conditions, zoom information, etc. (*see*

Itoh, col. 12), is “image data representing a plurality of images.” Applicants respectfully disagree. As supported by the specification and disclosure as a whole, one of ordinary skill in the art would recognize that “image data representing a plurality of images” refers to data containing information concerning the image itself. For example, the claim does not recite image data representing “photographic conditions” for a plurality of images, but that the image data represents the plurality of images *themselves*. In addition, claim 1 expressly recites “image recording time data representing times at which the image data is recorded.” In other words, the claim itself refers to the recording of an image as being related to the time at which the image data is recorded. If the “image data” of claim 1 could possibly be considered in the manner put forth by the Examiner, which Applicants do not concede is a reasonable interpretation, not only would the claim language be inconsistent, Itoh does not disclose recording the time at which this data, such as the title, photographing conditions, zoom information, etc., is recorded on the magnetic track. Itoh only discloses information regarding the time/date of photography (*see col. 12, lines 65*).

The Examiner cannot have “image data” read both ways. If the Examiner interprets “image data” as being extra data besides the image itself (to which Applicants object), then Itoh fails to disclose recording the time at which this extra data is recorded. If the Examiner interprets “image data” as the image itself, then Itoh fails to disclose electrically recordable and erasable image data due to the use of photographic film. In either instance, the cited reference fails to disclose all the features of the independent claim and, thusly, the rejection under § 102 fails to provide a *prima facie* case for anticipation.

Additionally, although Applicants acknowledge that Itoh discloses storing ordering information on the magnetic track (*see col. 12, lines 34-67*), Applicants submit that Itoh fails to teach or suggest recording on the recording medium designation time data representing the time at which the ordered image is designated. Itoh mentions storing “[i]nformation as to printing of the date and time of photographing” (*col. 12, lines 65-67*). However, this date and time only refers to when the image itself was photographed. The order information associated with this date and time is information

about whether this time/date data itself is to be printed with the image, e.g., as an annotation on the image. This is wholly different from recording the time/date of image designation on the recording medium.

Finally, regarding Figures 11 and 12, Itoh discloses an order certificate containing a date field. *See also col. 13, lines 54-67.* However, there is no disclosure as to whether this date corresponds to the date of ordering, a date of photography, or some other date. Even were this date to correspond to the date of ordering, which Applicants do not concede, there is still no disclosure that this date is stored on the recording medium with the ordering information. For at least this reason as well, claim 1 is distinct from Itoh.

Therefore, at least because Itoh fails to teach or suggest each and every claimed element, independent claim 1 is distinguishable from the prior art. Applicants herein apply to claim 11 the rationale presented above with respect to claim 1, and submit that independent claim 11 is likewise distinguishable from the prior art. Accordingly, Applicant respectfully requests that the rejection of claims 1 and 11 under 35 U.S.C. § 102(e) be withdrawn.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Notice of same is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John R. Sanders, Reg. No. 60,166, in an effort to expedite prosecution in connection with the present application.

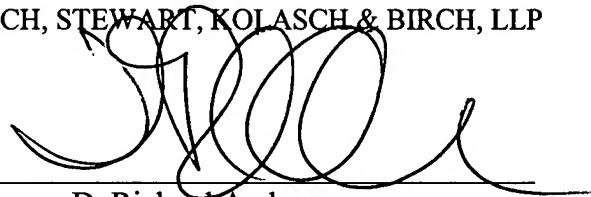
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Due Date: September 6, 2007

Respectfully submitted,

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